REMARKS

Summary of the Office Action

Claims 11-14 are pending in the application.

Claims 12 and 13 are objected to, but would be allowable if rewritten in independent form to include the limitations of all base claims. Applicant thanks the Examiner for indicating that claims 12 and 13 are directed to allowable subject matter.

Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over Suzuki et al (USP 6,097,842).

Claim 14 is rejected under 35 U.S.C. § 103 as being unpatentable over Suzuki et al in view of Pandel (USP 5,719,631).

These rejections are respectfully traversed.

Analysis of the Claim Rejections

Claim 11 recites, inter alia:

> generating an extended code (COD) field representing a coding state of said information; and

> including, in said extended code field, a bit stream indicating whether both a motion vector (MV) and a discrete cosine transform (DCT) value are not encoded, whether both the MV and the DCT are encoded, and whether only the MV is encoded, wherein said extended code field comprises at least two bits.

In rejecting claim 11, the Examiner cites Suzuki at Fig. 40A as teaching a COD, cites col.

33, lines 54-60 as teaching a bit stream indicating whether both a MV and a DCT value are not

encoded, cites col. 35, lines 1-8 as teaching whether both the MV and the DCT value are

encoded, and cites col. 34, lines 31-40 and col. 35, lines 1-3 as teaching whether only the MV is

encoded. Applicant respectfully submits that the Examiner is impermissibly intermixing the

functions of the COD with the functions of the MODB.

In more detail, Suzuki et al, at Fig. 40A and col. 33, lines 54-60 teaches a COD. This is

used for I-pictures and P-pictures. But at col. 35, lines 1-8, col. 34, lines 31-40 and col. 35, lines

1-3 Suzuki describes the MODB field used for B-pictures. The Examiner impermissibly

intermixes the functions of these two different fields to find attributes of the clamed COD field.

In the DECISION ON APPEAL, the Board of Appeals expressly addressed this issue on page 4:

> The Examiner also points to column 34, lines
> 31-40, and column 35, lines 1-8, of Suzuki for
> showing of a bit stream indicating whether both a
> MV and the DCT values are not encoded, whether both
> are encoded, or whether only the MV is encoded.
> These sections of Suzuki refer to Figure 40B, and
> an MODB flag, arranged next to the leading
> first_MMR_code.
>
> Thus, it would appear that the examiner
> relies on two different codes (COD and MODB) in
> Suzuki to provide for the functions of the
> instant claimed invention. However, independent
> claim 8 [the predecessor of present claim 11]
> calls for "generating *an* extended code (COD)
> field" (emphasis added), meaning a *single* code
> (COD) field. The claim further specifies that
> this single code field must include a bit stream
> and that bit stream in the single code field must

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> indicate "whether both a motion vector (MV) and a
> discrete cosine transform (DCT) value are not
> encoded, whether both the MV and the DCT are
> encoded, or whether only the MV is encoded."
> Therefore, if this were the examiner's only
> explanation of the rejection, it would fail.

In the present Office Action, this is the Examiner's only explanation of this aspect of the rejection, and therefore does not support the rejection. Although the Board's analysis was in the context of an anticipation rejection under 35 U.S.C. § 102, a similar analysis applies to the present rejection under 35 U.S.C. § 103.
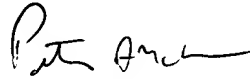
Reasoning similar to that presented above with respect to claim 11 applies to claim 14. The secondary reference, Pandel, does not make up for the deficiencies of Suzuki et al.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APP. NO. 09/203,672

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

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Respectfully submitted,

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Peter A. McKenna
Registration No. 38,551

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SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

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